

REMARKS
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***Amendment to the Claims***

The claims have been amended to maintain consistency in the use of singular terms (e.g. preparation vs. preparations). It is believed that no new matter has been added. Claims 1-4 and 9-16 are still pending.

***Double-patenting rejection***

Claims 1-4 and 9-16 were rejected as being obvious over claims 1-17 of U.S. Patent 6,592,883. However, even if this were presumed to be true (the applicants' also present that the '883 patent requires the presence of an amphiphilic boron nitride), the present application was filed on 18 July 2000 as a PCT application and as such the 20-year patent term would expire prior to the the 20-year term of the '883 patent (which was filed on 17 August 2000). Therefore, it is believed that no terminal disclaimer is required.

Applicants are unclear as to the rejection, if any, which was being made by the inclusion of paragraphs 19-22 (pages 5-6) of the examiner's office action or if the applicants' are being requested to take additional action. Applicants request clarification in the next communication if necessary.

***IDS based on subject matter for SN: 09/640,822***

Applicants' representative noticed certain similarities between the claims of SN: 09/640,822 and the present application. An IDS based on the references cited in the is application is being provided. For the reasons cited above, for the '883 patent, it is believed that a terminal disclaimer is not necessary as the '822 application was also filed on 17 August 2000. A copy of the claims currently pending in the '822 application is being provided with this office action.

***35 U.S.C. 102(b) rejection***

Claims 1-4 were rejected as being anticipated by Berthod et al. (U.S. Patent 4,446,051). The applicants request reconsideration for the following reasons.

*Standard of review*

In order for a reference to anticipate the applicant's claims, the reference must teach every element of the claim, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim." see MPEP 2131 and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989). However, Berthod et al. fails to meet this standard.

*Reasons why Berthod does not disclose applicants' invention in complete detail*

Berthod et al.'s invention is directed toward a high internal phase water-in-oil emulsion and discloses that the state of the art for such emulsions is that they were thought to be "intrinsically unstable" (see col. 2, lines 1-9). Berthod et al.'s solution to this problem is that such emulsions could be stabilized by using a specific combination of ingredients in specific amounts, i.e. (1) a branched chain non-polar oil, (2) a non-ionic liquid emulsifier having an HLB of 1 to 7; (3) a reaction product of sodium magnesium-fluorolithiosilicate trioctahedral montmorillonite clay and a quaternary ammonium salt and (4) a water soluble salt of magnesium (see col. 2, lines 10-33).

While Berthod et al. teaches a range of emulsifier which overlaps the range claimed by the applicants (i.e. at 0.5% by weight), this is only within the context of having all of elements (1)-(4) interacting together AND where it produces a high internal phase water-in-oil emulsion. Moreover, the preferred ranges of emulsifier (and which is actually supported by Berthod et al.'s examples) is 2% to 5% by weight (see col. 4, lines 15-22). In addition, applicants' claim 2 specifies that the water-in-oil system is "emulsifier-free" which is counter to the teachings of Berthod et al. ("If the emulsion contains less than 0.5% of emulsifier, it is unlikely that the emulsion, if obtained, will remain stable on storage, whereas if the emulsion contains more than 10% of emulsifier, the stability of the emulsion can be adversely affected" - see col. 4, lines 17-21).

For these reasons, one of ordinary skill in the art would not recognize that Berthod et al.'s invention would be readable upon teaching a water-in-oil system with just the four elements of the applicants' claims.

**35 U.S.C. 102(e)**

Claims 1-4 and 9-16 were rejected as being anticipated by Shiseido Co. Ltd. (JP 8-217619). It is noted that a holding of anticipation under 102(e) can only be applied if the reference meets the qualifications set forth under 706.07(f) which JP 8-217619 does not. Such that the next office action could

amend the rejection based on 102(b) or 103(a) grounds, the applicants offer the following comments (in addition an English language translation of this reference is being provided with this office action).

*Shiseido does not disclose applicants' invention in complete detail*

(Note: page numbers refer to the page number on the English language translation)

The essential elements of Shiseido's water-in-oil type cosmetic composition (see page 1 [Construction]) are:

- (1) an ultraviolet-ray inhibitor (pg. 7-8)
- (2) an organic denaturation clay material (pgs. 3-5)
- (3) a volatile component (pg. 3)
- (4) a spherical resin powder (pg. 5-6)
- (5) a coating agent (pg. 6)
- (6) an emulsifier (pg. 8)

(additional page numbers refer to section where more description of element is given) i.e. similar to the arguments made above with respect to Berthod et al., the Shiseido reference teaches an emulsion which possesses each of the essential elements cited above and does not contemplate a composition which can be formed at a minimum with the four elements of the applicants' claim, i.e. only the presence of an amphiphilic phyllosilicate and limited amount of emulsifier results in a useful composition.

The description offered in the Shiseido reference further confirms in at least three separate locations that the presence of emulsifier is a required element of their invention:

- (i) Page 1 [purpose] - "...where the emulsifying contents are stable even at high temperatures..."
- (ii) Page 9 [0017] - "In addition to the above-mentioned essential components..." - the previous paragraph [0016] described the scope of emulsifiers and therefore would be considered to be an essential component.
- (iii) The title of the invention itself suggests that the cosmetic composition contains an emulsifier.

As stated above, there is no teaching for an emulsifier-free water-in-oil preparation as is cited in applicants' claim 2. Furthermore, there does not appear to be any support within the Shiseido reference which indicates that the amount of emulsifier which can be used in 0.5% by weight or less as in the applicants' claim 1.

The only direction provided by Shiseido with regard to emulsifier content (and which still maintains the concept of their invention) is in their examples (embodiments):

Embodiment 1 (polyoxyethylene-methylpolysiloxane co-polymerizate) - 2%

Embodiment 2 (polyoxyethylene-methylpolysiloxane co-polymerizate) - 3%

Embodiment 3 (glyceryl monooleate 1.5%; diglyceryl di-isostearate 2.1%) - 3.6%

Embodiment 4 (methylpolysiloxane 4%; POE glycerol triisostearate 0.5%) - 4.5%

Embodiment 5 (polyoxyethylene-methylpolysiloxane co-polymerizate) - 3%

In each embodiment, Shiseido teaches using at least 2% by weight of emulsifier.

Further still, as there are six essential ingredients which comprise Shiseido's composition, the state of the art for emulsions is such that it cannot be asserted that one could arrive at the applicants' claimed emulsifier ranges through routine "trial and error" experimentation even if there was motivation from within the reference to do so (of which there is none).

For these reasons, it is believed that the Shiseido reference does not anticipate nor does it render the applicants' claimed invention to be obvious.

### **Closing**

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

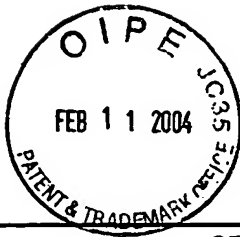
Respectfully submitted,

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Attachment: English language translation of JP 8-217619 (15 pages)  
Copy of pending claims from SN: 09/640,822 (3 pages)



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CERTIFICATE OF EXPRESS MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages) is being deposited as n express mail, label no. EV 383033736 US to the United States Patent and Trademark Office on the date indicated below:

Date: 11 February 2004

By: Agata Głinska  
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